

REMARKS

This Amendment responds to the Office Action dated February 12, 2004. A diligent effort has been made to respond to all of the objections and rejections contained in the Office Action and reconsideration is respectfully requested.

Claims 70-84 are pending. Claims 82-85 have been amended to overcome the claim objections raised in the Office Action.

1. The Examiner's "obviousness by inherency" Arguments are Improper

Claim 70 was rejected as being obvious over the combination of AirMobile, Bezaire and Eggleston. In order to sustain this rejection, the Office Action must establish the *prima facie* case, which requires that the prior art references must teach or suggest all the claim limitations. (MPEP 2143; 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.") Instead of following this primary rule of obviousness law, however, the Office Action instead relied upon the unsupported concept of obviousness by inherency.

Despite the combined teachings of the three applied references -- AirMobile, Bezaire, and Eggleston -- the Office Action invokes the concept of obviousness by inherency on four separate occasions in rejecting claim 70:

"(pp. 10-11, 31, wherein the "software program" is the program containing the filters, and the "software interface" *inherently* interfaces between the filter program and the user's mailbox...)" (Office Action at 4)

"... , the software program packaging the replicated new message into an electronic envelope, the envelope including addressing information associated with the wireless device (*inherent* in the step of forwarding messages from the messaging server to the wireless device);" (Office Action at 4)

"Receiving the electronic envelope at the wireless gateway and using the addressing information contained within the envelope in order to send the new messages to the wireless mobile communication device via the wireless network (*inherent* in the process of sending the messages through the wireless gateway to the wireless network); (Office Action at 5)

"... and storing the new message at the wireless device (p. 39, p 1, wherein removing the envelope and storing the message is *inherent* in order to allow a user to view the message). (Office Action at 5)

The Office Action provides no evidence whatsoever to support the proposition that any of the missing claim elements are "inherently" present in the prior art, and thus violates the basic rule of the law of obviousness -- the prior art references must teach or suggest all the claim limitations. The only reason that the Office Action is forced into this untenable and unsupportable *inherency* position is because the references plainly do not disclose the claimed subject matter. The rejections should be withdrawn.

2. AirMobile Does Not Disclose the Continuous Pushing Method of Claim 70

Claim 70 defines a specific method for continuous pushing of electronic messages from a messaging server to a wireless mobile device -- it does not purport to cover all methods of

pushing electronic messages. The claimed method requires that "for each of the wireless mobile communication devices, the software program registering with a software interface associated with the messaging server to receive a notification signal when a new received electronic message is received and stored in an associated mailbox," and then, "upon receipt of the notification signal for each of the new received electronic messages, the software program replicating the new message. . ."

Applicants do not dispute that the AirMobile manuals use the phrase "server push," in fact this was admitted in the last Amendment. This is not the point, however. Simply using the phrase "server push" is hardly sufficient disclosure to come to the conclusion, as the Office Action does, that the specific continuous pushing method of claim 70 is met. In fact, in the prior Amendment, applicants described in detail why the "server push" disclosure of the AirMobile reference is different from claim 70 and why it does not disclose the claimed steps. Simply put, this difference relates to "polling systems" versus "notification systems." Claim 70 describes an automated notification system whereas AirMobile describes a polling system. Applicants conclusively proved this distinction in the prior Amendment when describing the various polling parameters required in the AirMobile system:

Although some of the marketing literature for the AirMobile system describes it as a "push" system, AirMobile did not provide continuous replication as set forth in Claim 70. As explicitly detailed in the SERVER manual for the AirMobile system, several *polling parameters* were required at the AirMobile server, including a Scheduler Cycle Time parameter and a Inter-User Time-out parameter. According to the SERVER manual, the Scheduler Cycle Time parameter defines "*...the number of seconds to wait between checking active user's inboxes. For example, if you enter "30" in this field, the inbox of each active user will be checked every 30 seconds for the presence of messages.*" (AirMobile Communication Server Guide at 23) The Inter-User Time-out

parameter was used by the AirMobile server to *"defined the number of seconds to wait between checking the next user's inbox. Use this parameter to space out inquiries to a mail server."* (AirMobile Communication Server Guide at 23).

The fact that the AirMobile system even provides for these delay parameters clearly distinguishes it from Claim 70, in which there is no polling of the mail server at all, but instead the software interface provides an immediate and automatic notification to the software program performing the replication in order to provide continuous replication. In AirMobile there is no "software interface" between the messaging server (cc:Mail Server) and the software program (AirMobile server), nor is there any "notification signal" generated when a new message is received, nor is there disclosed the step of "registering" with the software interface. All of these steps in Claim 70 are simply missing from AirMobile. (Amendment dated Sept. 4, 2003, at 10-11)

The rejection of claim 70 should be withdrawn because AirMobile does not describe the automated notification system set forth in claim 70, but rather describes a semi-automated polling system.

3. There is No Such Device as a "Modem-Type Wireless Gateway"

Claim 70 requires that the electronic envelopes created by the software program are transmitted via a TCP/IP connection over a wired network to a wireless gateway system which then connects to a wireless network (Step (C) of Claim 70). The wireless gateway then receives the electronic envelopes and uses addressing information contained within the envelopes in order to send the replicated new message to the wireless mobile device via the wireless network (Step (D) of Claim 70). AirMobile does not include any such wireless gateway system, and thus cannot meet steps (C) and (D) of claim 70.

The Office Action tries unsuccessfully to show these limitations by inventing a new type of device -- something the Office Action refers to as a "modem-type wireless gateway." Outside of this Office Action, however, such a device does not exist. A modem is not a gateway. One of ordinary skill in the art would not refer to a modem as a gateway. As described in this application, a wireless gateway forms a connection or bridge between different networks. (Application, page 11, lines 9-11) Indeed, one of ordinary skill in the art would recognize this as the definition of a gateway: "A functional unit that interconnects two computer networks with different network architectures. A gateway connects networks or systems of different architectures." (IBM Dictionary of Computing, 10th Edition, at 295.) The same technical dictionary defines a modem as "A functional unit that modulates and demodulates signals." (IBM Dictionary of Computing, 10th Edition, at 438) A modem is not the same thing as a gateway, nor does it connect a wired network to a wireless network as required by claim 70. Rather, the wireless modem shown in the AirMobile reference enables a computer (the AirMobile Server) to communicate over the wireless network by modulating and demodulating data.

Moreover, the Office Action makes no attempt to show how the mythical "modem-type wireless gateway" uses the addressing information contained in the electronic envelope to deliver the envelope to the wireless device -- because it simply doesn't operate in this manner at all.

For this additional reason the rejection of claim 70 should be withdrawn.

4. Drawing Objections

Applicants traverse the objection made to the drawings. Claims 70-84 are method claims that describe the operation of a system. An embodiment of that system is adequately shown in

the existing drawings as Figures 1-3, and the accompanying textual description describes the method of operation set forth in claims 70-84. Moreover, various aspects of the claimed method are already described in flow chart form in Figures 4-5, some steps generally and some more specifically. The Office Action does not specifically point to any particular method step or limitation that is not adequately shown in the drawing figures and therefore it is impossible for applicants to know how to amend or add to the drawings to overcome this alleged deficiency. Thus, the objection is traversed.

5. Conclusion

For all of the reasons noted above it is believed that the pending claims 70-84 are patentably distinct from the prior art of record, and thus a notice of allowability is respectfully requested. Alternatively, the applicants invite the Examiner to contact their undersigned representative in order to further reduce any remaining issues in this case and bring about a conclusion to this matter.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "David Cochran", written over a horizontal line.

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